TFW 1649

**THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| In re Application of | : |
| | : Examiner: Aditi Dutt |
| Zhi-Cheng XIAO | : |
| | : Group Art Unit: 1649 |
| Application No. 10/537,757 | : |
| | : |
| Filing Date: June 6, 2005 | : |
| | : |
| For: NOGO, CASPR, F3 AND NB-3 USEFUL IN THE TREATMENT OF INJURY AND DISEASE TO THE CENTRAL NERVOUS SYSTEM | : |

**Certificate of Mailing Under 37 C.F.R. §1.8(a):**

I hereby certify that this correspondence is being deposited on November 13, 2006 with the United States Postal Service as first-class mail in an envelope properly addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Tina M. Doyle

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**TRAVERSAL AND REQUEST FOR RECONSIDERATION OF REQUIREMENTS FOR RESTRICTION AND ELECTION OF SPECIES**

Dear Sir:

The Official Action issued October 11, 2006 in the above-identified patent application requires restriction based on the examiner's determination that the claims of this application are directed to nine (9) separate patentably distinct inventions, as set forth at pages 2-3 of the Official Action. The October 11, 2006 Official Action further requires that applicant elect a single disclosed species of CNS disease or injury, as claimed in claim 18.

Applicant hereby traverses and requests reconsideration of these requirements for restriction and election of species.

The restriction requirement in this case is plainly improper for failure to comply with the relevant provisions of the Manual of Patent Examining Procedure (MPEP) pertaining to unity of invention determinations.

The present application was filed under 35 USC §371 as a U.S. national stage

application under the Patent Cooperation Treaty (PCT).

As stated in 1893.03(d) of the MPEP:

> Examiners are reminder that unity of invention (not restriction) practice is applicable in international applications (both Chapter I and II) and in national stage applications submitted under 35 USC 371 . . .
>
> The principles of unity of invention are used to determine the types of claimed subject matter and the combinations of claims to different categories of invention that are permitted to be included in a single international or national stage patent application. The basic principle is that an application should relate to only one invention or, if there is more than one invention, that applicant would have a right to include in a single application only those inventions which are so linked as to form a single general inventive concept.
>
> A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art . . . [emphasis added].

In the present case, the special technical feature which unifies the claims is the applicant's discovery that Nogo and Caspr interact with one another, and that this interaction is involved in myelination. Before the present invention, it was not known that this interaction took place, or that it was involved in myelination. This feature constitutes a common inventive concept underlying all of the various groups, and imparts unity of invention to all of the claims.

The examiner improperly attempts to support the present requirement by pointing to features in each of the various claim groups which are not present in other claim groups. However, the recitation of additional features in a claim does not alter the fact that all of the claims include a common special technical feature that satisfies the unity of invention requirement.

Furthermore, it appears that a complete search of any one of the nine claim groups identified in the October 11, 2006 Official Action would of necessity encompass the same art areas that should be considered with respect to the remaining eight claim groups. It is noteworthy in this regard that the examiner has failed to assert separate classification as warranting the present restriction requirement. Thus, the concurrent examination of claims 1-

9 and 16-26 in the present application should not materially affect the examiner's workload.

The impropriety of this restriction requirement is underscored by the fact that there was no lack of unity objection during the international stage of this application. Rather, the subject matter of all of the claims was treated as a single inventive concept. Accordingly, it should be evident that the present claims satisfy the unity of invention standards of the PCT.

Inasmuch as the October 11, 2006 Official Action fails to comply with the established U.S. Patent and Trademark Office unity of invention guidelines, as demonstrated above, it is respectfully submitted that this restriction requirement be reconsidered and withdrawn.

In order to be fully responsive to the above-mentioned requirements, applicant provisionally elects for examination in this application the subject matter of Group I, i.e., claims 1-4, 7-9 and 16.

Turning to the requirement for election of species, applicant provisionally elects multiple sclerosis (MS) from among the types of CNS disease or injury recited in claim 18.

It is believed that claims 1-4, 7-9 and 16-24 are readable on the elected subject matter.

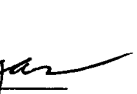
Applicant's elections in response to the present restriction and election of species requirements are without prejudice to applicant's right to file one or more continuing applications, as provided in 35 USC §121, on the subject matter of any claims finally held withdrawn from consideration in this application.

Lastly, it is noted that an initial shortened statutory response period of one (1) month was set in the October 11, 2006 Official Action. Accordingly, the initial due date for response is November 13, 2006, as November 11 fell on a Saturday. This Traversal and Request for Reconsideration and Election of Species is being filed before the expiration of the initial response period.

Early and favorable action on the merits of this application is respectfully requested.

Respectfully submitted,

DANN DORFMAN HERRELL and SKILLMAN, P.C.
Attorneys for Applicant

By 
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